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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,509	02/28/2002	Louis J. Panaccione	PURP01/0010	2163

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[REDACTED] EXAMINER

PATTERSON, MARIE D

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

3728

DATE MAILED: 06/16/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/086,509	PANACCIONE, LOUIS J.
	Examiner	Art Unit
	Marie Patterson	3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-23 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-23 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on 12 September 2002 is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |                                                                                                       |                                                                              |
|-------------------------------------------------------------------------------------------------------|------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                           | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 . | 6) <input type="checkbox"/> Other: _____                                     |

***Claim Rejections - 35 USC § 112***

1. Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 the phrase "selected from a plurality..." is vague and indefinite because it is not clear if applicant is positively reciting and claiming a single forefoot piece or a plurality of forefoot pieces.

In claim 11 the phrase "capable of initiating.." is functional, indefinite, and incomplete because it contains functional language not supported by recitation in the claim of sufficient structure to warrant the presence of such language.(MPEP2114) It is not clear what structural limitations applicant intends to encompass with such language.

In claim 13 the phrase "torsional geometry" is confusing, vague, and indefinite.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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3. Claims 1, 2, 4-6, 8-10, 12, 13, and 15 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Erickson (6408543).

Erickson shows an insole comprising a heel piece (24), a forefoot piece (22), interlocking and retaining means (26, 42, 58, 25b, and 59), and a forefoot cushioning means (27) as claimed.

4. Claims 1, 2, 5, 6, 8, and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Torchia (1733678).

Torchia shows an insole comprising a heel piece (1 and 2) with a first interlocking means (6), a forefoot piece (11) with a second interlocking means (12), means for retaining the pieces together (frictional engagement), and a heel cup (formed by element 15 and 14) as claimed.

5. Claims 1, 2, 4-6, 8-10, and 19-22 are rejected under 35 U.S.C. 102(b) as being anticipated by MacNamara (6092311).

MacNamara shows an insole comprising a heel piece (20) with first interlocking means (64, see column 4 lines 20-25), forefoot pieces (30, 40, and 50) some with a forefoot centering periphery (shown in figures 1A and 1B), and second interlocking means (62) as claimed.

#### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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7. Claims 3, 7, 14, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erickson or Torchia.

Erickson shows an insole substantially as claimed except for the exact means for retaining the interlocking means together and the exact material hardnesses. The use of adhesive to retain elements together is well known and conventional and also low tack adhesives are a well known alternative to hook and loop fasteners. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. It would have been obvious to provide adhesive and to use materials with hardnesses as claimed in the insole of either Erickson or Torchia to prevent the elements from sliding apart and to provide appropriate support and durability materials.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Erickson or Torchia in view of Dahle (5230170).

Erickson or Torchia shows an insole substantially as claimed except for a chemically reactive forefoot pad. Dahle teaches providing a chemically reactive forefoot pad (42) in an insole. It would have been obvious to provide a chemically reactive forefoot pad as taught by Dahle in the insole of either Erickson or Torchia to provide warmth to the foot in cold weather.

### ***Drawings***

9. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 9/12/02 have been approved by the Examiner. A proper drawing

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correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

1. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**. For applicant's convenience, the Group Technological Center FAX number is (703) 872-9302. (Note that the Examiner **cannot** confirm receipt of faxes) Please identify Examiner \_\_\_\_\_ of Art Unit \_\_\_\_\_ at the top of your cover sheet of any correspondence submitted.

Inquiries only concerning the **merits** of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to (703) 308-1337.

Check out our web-site at "[www.uspto.gov](http://www.uspto.gov)" for fees and other useful information.



Marie Patterson  
Primary Examiner  
Art Unit 3728